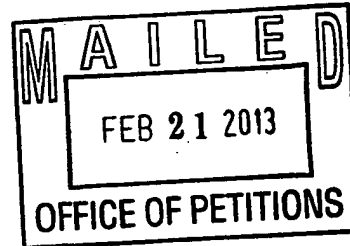




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In re Patent No. 7,341,744	:	
Rozhon et al.	:	DECISION UPON REMAND AND
Issue Date: March 11, 2008	:	RECONSIDERATION OF
Application No. 09/712,033	:	PATENT TERM ADJUSTMENT
Filed: November 14, 2000	:	and
Atty Docket No. 83793(47381)	:	NOTICE OF INTENT TO ISSUE
	:	CERTIFICATE OF CORRECTION

This is a decision following remand from the District Court for the District of Columbia regarding the patent term adjustment indicated on the above-identified patent. The Court remanded this matter to the U.S. Patent and Trademark Office for recalculation of the patent term adjustment in accordance with the decision in Wyeth & Elan Pharma Int'l Ltd. v. Kappos, 591 F.3d 1364 (Fed. Cir. 2010).

The patent term adjustment indicated on the above-identified patent has been recalculated as directed by the Court. The term of the above-identified patent is extended or adjusted by four hundred fifty-two (452) days.

**BACKGROUND**

This patent issued on March 11, 2008, with a patent term adjustment of 453 days. On May 6, 2008, patentees timely filed a request for reconsideration of patent term adjustment pursuant to 37 C.F.R. §1.705(d), requesting correction of the patent term

adjustment to either 1007<sup>1</sup> days or 743<sup>2</sup> days. Prior to a decision being issued by the United States Patent and Trademark Office, on September 5, 2008, patentees filed a complaint in the United States District Court for the District of Columbia. Pursuant to 35 U.S.C. § 154(b)(4)(A), patentees sought a judgment that the patent term adjustment in the above-identified patent be increased from 453 days to 1007 days.

By Order dated May 19, 2010, the Court vacated the existing patent term calculation and remanded the matter to the United States Patent and Trademark Office for recalculation and adjustment of the disputed patent term in accordance with the decision of the United States Court of Appeals in Wyeth & Elan Pharma Int'l Ltd. v. Kappos, 591 F.3d 1364 (Fed. Cir. 2010).

As directed, the Office has recalculated the disputed patent term adjustment.

#### OPINION

Having recalculated the patent term adjustment, it is determined that the correct patent term adjustment for the above-identified patent is 452 days.

With respect to "A" delay, it is undisputed that the period of adjustment is 573 days (554 + 19) days. With respect to "C" delay, it is undisputed that the period of adjustment is 0 days. At issue is the period of adjustment for "B" delay and for applicant delay.

The application was filed on November 14, 2000 and issued on March 11, 2008. However, a request for continued examination (RCE) was filed on September 27, 2006. As the period from the filing date of the request for continued examination (RCE) to the issue date of the patent is not included in the period of B delay, the over three year period began on November 15, 2003, and ended on September 26, 2006, the day before the RCE was filed, and is 1,047 (not 1,048 as calculated by patentees including the day of filing of the RCE) days. See 35 U.S.C. § 154(b)(1)(B)(i).

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<sup>1</sup> Patentees state that this number is based on the Office's calculation of 1048 days of 1.703(b) delay.

<sup>2</sup> Patentees state that this number is based on their calculation of 1.703(b) delay.

Further, patentees' calculation of 1007 days of patent term adjustment does not consider that the B delay does not include any time consumed by appellate review. Based on the rules in effect at the time of issuance of the patent and at the time of remand of this case, there are two periods of appellate review<sup>3</sup>: i) a Notice of Appeal was filed on January 28, 2005, and a non-final Office action was mailed on March 21, 2005, and ii) a Notice of Appeal was filed on February 27, 2006, and a request for continued examination was filed on September 27, 2006 (It is noted that September 27, 2006 was previously excluded as time consumed by continued examination. Thus, this second period does not include for time consumed by appellate review September 27, 2006. Rather, the time consumed begins on February 27, 2006 and ends on September 26, 2006). Accordingly, 53 and 212 days respectively of the over three year period are considered consumed by appellate review, and are not included in the B delay. See 35 U.S.C. § 154(b)(1)(B)(ii).

Thus, the period of B delay is 782 (1047 - 265) days.

Considering the 265 (53 + 212) days excluded for appellate review, the period of overlap is 19 days.

Accordingly, a period of 763 days is being entered for B delay of 782 days - 19 days of overlap.

Patentees do not dispute the applicant delay of 595 days. However, a review of the calculations reveals that correction of two periods of reduction for applicant delay is warranted. First, the period of reduction of 350 days entered for applicant delay, pursuant to 35 U.S.C. § 154(b)(2)(C) and 37 CFR 1.704(b), is incorrect. Rather, a period of reduction should have been calculated pursuant to 35 U.S.C. 154(b)(2)(C)(iii) and 37 CFR 1.704(c)(7) due to abandonment of this application as a result of failure to file a response to the Notice to File Missing

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<sup>3</sup> The Office's former interpretation of appellate review: An appeal to the Board of Patent Appeals and Interferences commences with the filing of a notice of appeal. See 35 U.S.C. 134(a). Generally, an appeal to the Board of Patent Appeals and Interferences ends with either 1) a Board decision, 2) the examiner reopening prosecution and issuing another Office action, or 3) the applicant filing a request to withdraw the appeal and reopen prosecution (e.g. the filing of a request for continued examination).

Parts of Application mailed April 18, 2001. 37 CFR 1.704(c) states, in pertinent part, that:

Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

(3) Abandonment of the application or late payment of the issue fee, in which case the period of adjustment set forth in §1.703 shall be reduced by the number of days, if any, beginning on the date of abandonment or the date after the date the issue fee was due and ending on the earlier of:

(i) The date of mailing of the decision reviving the application or accepting late payment of the issue fee; or

(ii) The date that is four months after the date the grantable petition to revive the application or accept late payment of the issue fee was filed;

Therefore, patentees should have been assessed delay for the period from June 19, 2001 (the date the application became abandoned) to March 21, 2003 (the date the decision reviving the application was mailed in response to the renewed petition filed March 17, 2003), or 641 days. Accordingly, the period of reduction of 350 days has been removed and a period of reduction of 641 days has been entered.

Second, the period of reduction of 2 days entered for applicant delay, pursuant to 35 U.S.C. § 154(b)(2)(C) and 37 CFR 1.704(b), is not warranted. The reply was timely filed pursuant to 35 U.S.C. §21(b). The due date for reply to the Office action mailed June 15, 2007, was September 15, 2007, which fell on a Saturday. A reply was timely filed on Monday, September 17, 2007. Thus, a period of reduction of 2 days should not have been entered. Accordingly, the period of reduction of 2 days has been removed.

Thus, the total period of applicant delay<sup>4</sup> is 884 (641 + 89 + 29 + 29 + 89 + 7) days.

In view thereof, the patent should have issued with a revised patent term adjustment of  $[A = (554 + 19) = 573 \text{ days}] + [B = 782 \text{ days}] + [C = 0 \text{ days}] - [\text{overlap} = 19 \text{ days}] - [\text{applicant delay} = 884] = 452 \text{ days}$ .

Patentees' attention is directed to the final rule, *Revision of Patent Term Adjustment Provisions Relating to Appellate Review* (77 FR 49354) issued on August 16, 2012. Patentees are given a two-month period from the date of this decision limited to reconsideration of the Office's former interpretation of the appellate review language of 35 U.S.C. 154(b)(1)(B)(ii) and (C)(iii), in light of the final rule, *Revision of Patent Term Adjustment Provisions Relating to Appellate Review* (77 FR 49354) issued on August 16, 2012. As per the rule, patentees must request application of the new interpretation. The Office will not *sua sponte* reconsider and recalculate the period of appellate review. Nonetheless, in this instance, patentees are advised that under the revised interpretation of appellate review, the reductions totaling 265 (53 + 212) days of B delay pursuant to 35 U.S.C. 154(b)(1)(B)(ii) and new 37 CFR 1.703(b)(4) would be removed because jurisdiction over the application did not pass to the Board under 37 CFR 41.35(a) during these two periods of appellate review. *Revision of Patent Term Adjustment Provisions Relating to Appellate Review*, 77 FR 49354 (August 16, 2012)<sup>5</sup>.

### CONCLUSION

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by four hundred fifty-two (452) days.

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<sup>4</sup> It is noted that given the withdrawal of the finality of the Office action mailed September 17, 2004, both Office delay and applicant delay were properly calculated based on a proper response having been filed on November 2, 2004 (see non-final Office action mailed March 21, 2005).

<sup>5</sup> It is noted that the revisions to 37 CFR 1.704(c)(11) apply only to applications in which the notice of appeal was filed on or after September 17, 2012.

The Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. The Office, pursuant to 37 CFR 1.322, normally sets a one month or thirty (30) day period, whichever is longer, from the mail date of this decision to respond. However, given the revisions to the interpretation of appellate review discussed above, patentee is given **two (2) months** from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

Telephone inquiries regarding this matter should be directed to Senior Petitions Attorney, Nancy Johnson at (571) 272-3219.

/Nancy Johnson/

Nancy Johnson  
Senior Petitions Attorney  
Office of Petitions  
Office of Associate Commissioner  
For Patent Examination Policy

Enclosure: Draft Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE  
**CERTIFICATE OF CORRECTION**

PATENT : 7,341,744 B1

DATED : March 11, 2008

**DRAFT**

INVENTOR(S) : Rozhon et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[\*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 453 days

Delete the phrase "by 453" and insert – by 452 days--